

REMARKS

In the Office Action dated January 11, 2005, claims 1-9 and 11-20 were presented for examination. Claims 9 and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 1-8, 11-17, 19 and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by *Klein et al.*, U.S. Patent No. 6,138,194.

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of January 11, 2005 for the pending application.

I. Rejection of claims 1-8, 11-17, 19, and 20 under 35 U.S.C. §102(b)

In the Office Action of January 11, 2005, the Examiner assigned to the application rejected claims 1-8, 11-17, 19, and 20 under 35 U.S.C. §102(b) as being anticipated by *Klein et al.* ('194). The *Klein et al.* patent ('194) relates to an apparatus for sensing movement of a bus card and control of the delivery of power in response to movement of the card. Applicant hereby incorporates the comments presented in response to the First Office Action regarding *Klein et al.*

The *Klein et al.* patent discloses several different embodiments for sensing movement and controlling delivery of power associated with a bus card. In the embodiment shown in Figs. 2 and 5, the sensor is internal to the connector. However, in the embodiment shown in Fig. 4, the sensor is external to the connector. The Abstract specifically states its discussion of "one embodiment." See Abstract, line 1. As shown in Fig. 2, an optical card detector 210 is provided "within the physical slot 204", i.e. internal to the slot, see Col. 4, lines 31 and 32, and not external to the slot. The Abstract further states, "This apparatus includes . . ." and continues with a recitation of the elements described in detail as the embodiment depicted in Figs. 2 and 5. See Abstract, line 5 *et seq.* It is this embodiment that supports detection of initial movement. See Col. 4, lines 59-66. It is therefore the internally located sensor of *Klein et al.* illustrated and depicted in Figs. 2 and 5 that communicates an initially detected movement from the card to a switch – not the embodiment depicted in Fig. 4. Accordingly, the embodiment elaborated on in

the Abstract is the embodiment illustrated in Fig. 2 and depicted in Fig. 5 – not the embodiment depicted in Fig. 4.

Additionally, Fig. 4 of *Klein et al.* is the only embodiment of a sensor located “outside of bus connector 402.” See Col. 6, lines 9-10. As noted in Col. 6, line 12, this external sensor functions with a “fully inserted card”. As shown in Applicant’s Fig. 2 and recited in amended claims 1 and 12, the detector of Applicant is not only external to the connector holding the module, but also manages initial motion, *i.e.* a signal of an impending disconnect of the card, through the use of a sensor and a switch within the external detector. See Page 8, lines 12-14. Although Applicant’s invention is a detector that includes two primary components, a sensor and a switch, the embodiment depicted in Fig. 4 of *Klein et al.* only depicts a detector containing a switch. Accordingly, there is no express or inherent support in *Klein et al.* for an external detector incorporating a sensor and a switch that detects initial movement of the card.


Furthermore, with respect to Applicant’s claims 1 and 12, there is no teaching in *Klein et al.* for locating the sensor external to the connector holding the module and detecting initial motion. In fact, Fig. 2 of *Klein et al.* clearly shows that the card detector 210 is within the physical slot 204 adapted to house the card, and that within this embodiment it detects initial motion. See Col. 4, line 59. However, with respect to the embodiment shown in Fig. 4, *Klein et al.* specifically states that a signal is initiated in response to the card being “fully inserted” without reference to motion – initial or otherwise. Applicant has previously amended claims 1 and 12 to specify that the sensor of Applicant is not within the connector, together with the original language that supports activation of a switch in response to an initial motion. In order for the claimed invention to be anticipated under 35 U.S.C. §102(b), the prior art must teach all claimed limitations presented by the claimed invention. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP §2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)). As mentioned above, *Klein et al.* does not expressly or inherently show one embodiment that includes all of the elements as claimed by Applicant in pending claims 1 and 12. Specifically, *Klein et al.* does not support

placement of a sensor external to the connector together with sensing of initial motion. Rather *Klein et al.* incorporates their initial motion sensor internal to the connector only within one embodiment, Fig. 2. Although Fig. 4 of *Klein et al.* shows an alternative embodiment with a mechanical sensor 406 mounted external to the connector, this sensor only functions when the card is "fully inserted" into the associated connector. The current standard of the law is clear that for an element to be inherently disclosed an application is to show that the "necessary and only reasonable construction to be given the disclosure by one skilled in the art." *Kennecott Corp. v. Kyocera International Inc.*, 835 F.2d 1419, 5 USPQ2d 1194 (Fed. Cir. 1987). Applicant's sensor is calibrated to detect "initial motion" and is not limited to sensing a complete connection associated with a full insertion into a connector slot. There is no express or inherent teaching in *Klein et al.* that the external sensor will detect initial motion and act on the initial motion prior to disconnect, as claimed by Applicant. Surely, the sensor 406 of *Klein et al.* may be limited to detecting full insertion of a card into the connector, as there is no teaching or suggestion, whether express or inherent, to support that an externally mounted sensor may detect and act upon initial motion prior to disconnect. Accordingly, *Klein et al.* clearly fails to expressly or inherently teach the limitations pertaining to the location of the sensor with respect to the connector as presented in Applicant's pending claims 1 and 12.

Accordingly, for the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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